

REMARKS

Claims 1-16 are pending upon entry of the present amendment.

Claim 1 stands rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,644,173 to Lazaris et al. Lazaris does not disclose first and second piercing elements formed as a single removable unit that is unattached to the beverage preparation machine. Instead, Lazaris discloses that its platen 40 carrying the probes 42 and 44 is shifted between a retracted and an advanced position by a pneumatic cylinder 46. Figure 4 of Lazaris illustrates that the platen 40 is attached to the pneumatic cylinder 46. The present application states that the removable unit "allows for easy cleaning of the components of the machine" (p. 3). The attachment of the platen 40 to the pneumatic cylinder 46 of Lazaris would make it difficult to achieve this same advantage. Thus, it is respectfully submitted that claim 1, as presently recited, is not anticipated by Lazaris.

New claims 10-16 depend directly or indirectly from claim 1 and thus are also not anticipated by Lazaris.

Claims 2-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaris in view of U.S. Patent No. 5,794,519 to Fischer. Claim 2 has been amended into independent form by incorporating the elements of original base claim 1. It is respectfully submitted that claims 2-4 patentable over the references.

Lazaris does not disclose a fixed lower part and an upper part rotatable relative to the lower part where the removable unit is mounted, in use, in the fixed lower part. The Office action states that it "would have been obvious to one skilled in the art to provide the machine of Lazaris with the fixed lower part and rotatable upper part disclosed in Fischer" (p. 2). However, the Office action fails to identify any motivation in either reference for their proposed combination. Indeed, such motivation is not present because the disclosures of both Fischer and Lazaris teach away from such a combination.

Fischer discloses an upper brewing head part 1 having depending needles 9 that are used to inject brewing water into a capsule 30 and a lower brewing head part 2 having a pyramid plate 8 through which the brewing water and dissolved coffee components exit. Thus, the capsule of Fischer is pierced from opposite sides.

Lazaris describes cartridges that are pierced in opposite directions as having certain problems and disadvantages. (Col. 1, ll. 29-55.) Lazaris states that it addresses these problems by "redesigning and rearranging the cartridge components, resulting in the first and

Application No. 10/763,928
Amendment dated April 6, 2006
Reply to the Office action of March 2, 2006

second chambers being accessible, respectively, by inlet and outlet probes acting on one side of the cartridges to pierce only the lid." (Col. 1, ll. 56-61.) When applying 35 U.S.C. 103, one of the tenets of patent law that must be adhered to is that the "references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." (MPEP 2141.) Accordingly, the specific disclosure in Lazaris that piercing from opposite directions, as is disclosed in Fischer, is a problem with the prior art precludes the proposed combination of Lazaris and Fischer.

New claims 5-9 depend directly or indirectly from claim 2 and thus are also submitted to be patentable over the cited references.

For the reasons set forth above, claims 1-16 are believed to be allowable over the cited references, and reconsideration and allowance of claims 1-16 are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

Date: April 6, 2006



Jon A. Birmingham
Registration No. 51,222

FITCH, EVEN, TABIN & FLANNERY
120 S. LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: 312.577.7000
Facsimile: 312.577.7007

445058